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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,128	12/30/2000	Yosef Freedlan	JST-15	1786

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EXAMINER

FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/753,128

Applicant(s)

FREEDLAN, YOSEF

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 1-63, 65, 72, 75-78, 80, 90-93, 95, 99, 105-108, 110, 112, 114, and 120-133 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64, 66-71, 73, 74, 79, 81-89, 94, 96-98, 100-104, 109, 111, 113, 115-119 and 134-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

U.S. Patent and Trademark Office  
PTOL-326 (Rev. 04-01)

**Office Action Summary**

Part of Paper No. 9

Continuation of Disposition of Claims: Claims pending in the application are 64,66-71,73,74,79,81-89,94,96-98,100-104,109,111,113,115-119 and 134-137.

Art Unit: 3743

## DETAILED ACTION

### *Response to Amendment*

This is a response to the amendment dated August 21, 2003. Claims 64-137 are pending and claim 1-63 have been cancelled.

1. The amendment filed August 21, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- An orthopedic securing system for securing at least one elongate element **to a tissue**
- A nut surface that substantially **contacts a tissue surface**
- At least one elongate element that comprises **at least two elongate elements**
- An elongate member that comprises a **wire**
- A nut surface that is juxtaposed **against the tissue surface** via the at least one elongate element
- A band around the periphery of the assembled nut that **does not contact the tissue surface**
- A band around the periphery of the assembled nut that **contacts the tissue surface**
- The **periphery height along the axis of the nut that is equal to or less than the height of the band** along the axis of the nut

- ***One or more prongs*** extending from the assembled nut adapted to ***contact a tissue***
- ***A natural dissolution period such that during this period it substantially dissolved in vivo implantation and an inducible dissolution period that differs from the natural dissolution period***
- A compression surface adjoining at least one inner surface with the periphery, the compression surface juxtaposed ***against the tissue*** surface in the assembled nut
- A compression surface that remains juxtaposed ***against the tissue surface*** when the band is disposed around one or more of the diameters.

Applicant has elected the species of Figures 118-131. Neither the specification nor drawings support the split suture nut in tissue. There is no recitation or drawings showing tissue or the specifics as added to the claims. Neither the specification nor drawings show plural elongate elements, a wire, prongs, etc. Further dissolution periods also were not discussed. Thus, this constitutes new matter, for the details were not provided in the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Applicant has appointed an attorney or agent to conduct all business before the Patent and Trademark Office. **Double correspondence with an applicant and applicant's attorney or agent will not be undertaken.** Accordingly, applicant is

required to conduct all future correspondence with this Office through the attorney or agent of record. See 37 CFR 1.33.

Unless the power of attorney is revoked, the office will not correspond to applicant.

***Specification***

3. The disclosure is objected to because of the following informalities: page 47, lines 25-26 recite, "Once the Suture Split-nut is in place, the band is **moved from the surface R1 to the surface R1...**" There appears to be a typographical error.

Appropriate correction is required.

***Election/Restrictions***

4. Newly submitted claims 65, 72, 75, 76, 77, 78, 80, 90, 91, 92, 93, 95, 99, 105, 106, 107, 108, 110, 112, 114, and 120-133 are directed to an invention that is independent or distinct from the invention/species originally claimed/elected for the following reasons: applicant elected the species of a Split Suture Nut of Figures 118-131, where the claims listed above are not directed to that described in the specification or shown in the drawings for that invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 65, 72, 75, 76, 77, 78, 80, 90, 91, 92, 93, 95, 99, 105, 106, 107, 108, 110, 112, 114, and 120-133 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 74 recites the limitation "the smaller diameter" and "the larger diameter" in line 3. There is insufficient antecedent basis for these limitations in the claim.

7. Claim 81 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 81 depends from claim 79. Claim 81 recites, "the radial axis of the band is equal to the height of the radial axis of the nut." This contradicts claim 79, which recites, "the radial axis of the band being less than the height of the radial axis of the nut." It is impossible for the radial axis to be both less than and equal to. Therefore, claim 81 cannot be examined.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 64, 66-71, 73, 74, 79, 81-89, 94, 96-98, 100-104, 109, 111, 113, 115-119, and 134-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Seegmiller et al. in US Patent No. 5,525,013.

Seegmiller et al. disclose:

- A nut surface, see figure 11
- One or more elements channels (the area of 63A) extending substantially along the radial axis of at least one of the two or more nut sections, the one or more element channels adapted to press at least one elongate element, as recited in column 8, lines 15-23
- An outer surface defining a periphery of the nut sections
- A band (65) disposed around the periphery
- At least one portion of the one or more element channels having a friction surface, as seen in figure 11
- An elongate element that is one of a wire or suture, as recited in column 8, lines 15-23
- A periphery height along the axis of the nut that is greater than the height of the band along the axis of the nut, as seen in figure 11
- A periphery that has at least two diameters and the band is disposed around one or more of the diameters, figure 11 (shows a taper as well as a groove 64 which changes the diameter)
- One or more element channels that maintain their position along the at least one elongate element when the band is moved from encircling a smaller diameter to encircling a larger diameter of the at least two diameters, is seen in figure 11 (where when the band is removed the elements are capable of maintaining their position)



- Two or more inner surfaces adapted to clamp at least one elongate element, as recited in column 8, lines 15-23
- An outer surface defining a periphery
- A band that substantially surrounds the periphery, the height of the radial axis of the band being less than the radius axis of the nut, as seen in figure 11
- At least one first nut section (63) having a first clamping surface adapted to clamp at least one elongate member and a first compression surface adjoining the first clamping surface, as seen in figure 11
- At least one second nut section (63) having a second compression surface, as seen in figure 11

Seegmiller et al. do not explicitly recite to secure the at least one elongate element to a tissue where the nut surface contacts the tissue surface, wherein the nut surface is juxtaposed against the tissue surface via the at least one elongate element, a band that does not contact the tissue surface, or a band that contacts the tissue surface.

However, this was not originally presented with these specifics in the specification or drawings. In any event, it would be obvious to employ the teachings of Seegmiller et al. in a suture retaining device for it is well known analogous to retain sutures in similar ways to wires and cables.

#### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO

  
Henry A Bennett  
Supervisory Patent Examiner  
Group 3700